

### REMARKS

Claims 1-29 are amended. Independent claims 12 and 18 are amended to indicate the use of a processor and network, respectively. Claims 30-39 are new. Claims 1-39 are pending.

The disclosure is amended to correct informalities at page 3, lines 18 and 31 and page 10, line 8. Applicant respectfully requests that objections to the pending claims and disclosure be withdrawn. No new matter has been added.

Claims 1-11 stand rejected under 35 U.S.C. 101 for allegedly not reciting statutory subject material. Independent claim 1 is amended to recite an article that comprises "a machine-readable medium storing machine-readable instructions" to indicate that the claimed invention is directed to statutory subject matter. Applicant respectfully requests that the 35 U.S.C. Section 101 rejection be withdrawn.

New dependent claims 30, 32, 34, 36 and 38 recite features relating to the incorporation of an icon into a message without an attachment and new dependent claims 31, 33, 35, 37 and 39 recite features relating to the naming of the icon in the message without an attachment. An example of incorporating and naming an icon into a message without an attachment is discussed in connection with FIG. 8 of the specification:

Figure 8 shows the process by which the recipient list is processed to enable split distribution of attachments in accordance with a preferred embodiment of the present invention. As shown in the figure, recipient list 150 is examined at step S200 and sorted by attachment designation. The recipients that have been designated as "with attachment" are added to recipients to receive attachments 160 and at step S250 the message and attachment or attachments are sent. Those recipients that have been designated as "without attachment" are added to recipients not receiving attachments 170 and at step S300 have the attachment removed from the message. Next, at step S400, the name of the attachment is stored, at step S500 a ghost icon is created and named for the name of the attachment that will not be sent, and, at step S600, the ghost icon is inserted into the message to replace the file. Next, at step S700, the message is sent with the icon but without the attached file.

None of the cited references discloses or suggests the incorporation of an icon into a message without an attachment or naming the icon in the message without an attachment as recited in dependent claims 30-39, respectively. In view of the foregoing remarks, applicant respectfully requests allowance of claims 30-39.

Claims 1-5, 7-16, 18-22 and 24-28 stand rejected under 35 U.S.C. Section 102(e) for being allegedly anticipated by U.S. Patent Number 6,192,396 to Kohler ("Kohler"). Applicant respectfully traverses this rejection.

Independent claim 18 as amended, recites, in part, a method for transmitting electronic mail that includes designating at least one recipient of a plurality of recipients to receive a message and attachment, designating at least one recipient of the plurality of recipients to receive a message without the attachment, and transmitting the message over a network using less bandwidth of the network for the message without the attachment than the message with the attachment. Independent claims 1, 7, 12 and 24 recite similar features.

An example of an e-mail system for transmitting e-mail messages in a multi-networked environment is discussed in connection with FIG. 1. As discussed above, an example of a process for transmitting messages with attachments and the same messages without attachments is discussed in connection with FIG. 8 of the specification. In the FIG. 8 example, an e-mail message with an attachment designated as "without attachment" is added to a list of recipients not receiving attachments. The attachment is then removed from the e-mail message and an icon is created and named for the name of the attachment that is not to be sent. The icon is then inserted into the e-mail message to replace the attachment. Once replaced, the message is sent with the icon but without the attached file. (Application, page 21, line 27 – page 22, line 13)

As discussed in the specification, a large amount of network communications bandwidth can be consumed when transmitting electronic messages with attachments. (Application, page 4, lines 23-27) By replacing the attachment with an icon in an e-mail message designated as "without attachment", transmitting the e-mail message without the attachment over a network uses less network bandwidth than the same e-mail message with the attachment.

The Kohler reference relates to a messaging system which generates messages that contain recipient-specific content. The reference discusses identifying one or more recipients to

which at least one portion of a message will be sent (Kohler, col. 2, lines 12-17, FIGS. 6a-c, 7a-c, 8a-c, 9a-b ) and discusses that recipients of attachments can be designated in a similar manner (Kohler, col. 8, lines 44-51). The Kohler reference, however, does not teach transmitting the message over a network using less bandwidth of the network for the message without the attachment than the message with the attachment as recited in the pending claims.

In view of the foregoing remarks, applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 7, 12, 18 and 24. Claims 2-5, 8-16, 19-22 and 23-28 should be allowed at least for the same reasons.

Claims 6, 17, 23 and 29 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Kohler in view of U.S. Patent Number 5,917,489 to Thurlow et al. ("Thurlow"). Applicant respectfully traverses this rejection.

Amended dependent claim 23 recites, in part, a profile that includes the recipient's preferences with regard to receipt of current and prospective attachments. Dependent claims 6, 17 and 29 recite similar features.

An example of setting a profile that includes the recipient's preferences as to current and prospective attachments is explained on page 20 of the specification. As explained in that example:

At the recipient side, potential recipients preferably can select from reception options with regard to receipt of attachments to form a reception profile. For example, users of the e-mail system can specify that they cannot receive attachments larger than a particular size. Preferably, other options can be selected. The program preferably can be set such that certain dates will be blacked out with regard to reception of attachments. For example, if the recipient will be out of town for a two week period, he or she can select to accept no attachments during that period, or no attachments except for those sent from a particular sender or senders.

(Specification, page 20, lines 18-30)

The Thurlow patent relates to a desktop information manager that includes a "Rules Wizard" for creating and editing rules for processing electronic messages. Although the reference discusses profiles, it does not disclose or suggest the claim limitations missing from the

Kohler reference. In particular, there is no suggestion that the profiles disclosed in the Thurlow patent include the recipient's preferences with regard to receipt of current and prospective attachments. The Thurlow patent does not disclose or suggest the claim features missing from the Kohler reference.

In view of the foregoing remarks, applicant respectfully requests reconsideration and withdrawal of the rejection of dependent claims 6, 17, 23 and 29.

New dependent claims 30, 32, 34, 36 and 38 recite features relating to the incorporation of an icon into a message without an attachment and new dependent claims 31, 33, 35, 37 and 39 recite features relating to the naming of the icon in the message without an attachment.

In view of the foregoing remarks, applicant respectfully requests allowance of claims 30-39.

### Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the comments made above may not be exhaustive, there will likely be reasons for patentability of the pending claims that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

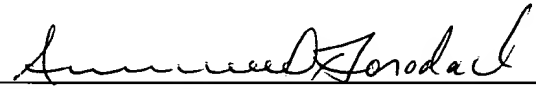
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In view of the foregoing remarks, applicant respectfully requests allowance of the claims.  
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Respectfully submitted,

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